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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,385	07/27/2001	Karl-Heinz Schwonke	D078 1130.1	7824

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EXAMINER

AHMED, SHEEBA

ART UNIT	PAPER NUMBER
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1773

MAIL DATE	DELIVERY MODE
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06/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/916,385

Applicant(s)

SCHWONKE ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19,20,22-31,37,39,41,43-54,56-58 and 74-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 76 and 77 is/are allowed.
- 6) ☒ Claim(s) 19,20,22-31,37,39,41,43-54,56-58,74,75,78 and 79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendments to claim 77 have been entered in the above-identified application. Claims 38, 40, 42, and 55 have been previously cancelled. **Claims 19, 20, 22-31, 37, 39, 41, 43-54, 56-58, and 74-79 are pending and under consideration.**

The rejection of claims 19, 20, 22-31, 37, 39, 41, 43-54, 56-58, and 74-79 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn in light of the Applicants arguments. Specifically, the Applicants assert that the phrase "over the entire thickness" is clear from Figure 3 (on Sheet 3 of 3) of the instant application and from the explanation provided in paragraph [0010] in the published application of the present invention, Patent Application Publication No. US2002/0020128, which states, ... the flakes have the advantage to essentially orientate fiat to the linoleum surface within the calender nip. Owing to the rather two-dimensional fiat-shaped particle structure of the flakes, the alignment takes place over the whole cross section of the final planar structure, i.e. on the upper side as well as the lower side, so that the flakes are uniformly distributed over the entire structure. This specific structure thus obtained guarantees a completely patterned planar structure that maintains the specific patterned structure even at stronger abrasion.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 19, 20, 22-31, 37, 39, 41, 43- 54, 56-58, 74, 75, 78, and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Dobry et al. (US 2,962,081).

Dobry et al. disclose plastic composition sheets that are adapted for use as floor coverings wherein the process of making such a plastic composition sheet entails depositing uniformly on a backing material a smooth layer of a mixture of fine particles and flat plastic chips (Column 1, lines 49-65). The plastic chips are about 0.18 to 1.0 inches in diameter (equivalent to 4.57 to 25.40 mm) and have a thickness of 0.01 to 0.025 inches (equivalent to 254-635 microns) (Column 2, lines 37-45). The process of the disclosed invention is applicable to various types of plastic compositions used in surface coverings including linoleum (Column 2, lines 71-72). If the plastic composition is linoleum then the linoleum is composed of drying oils, resin, fillers and pigments. The oil can be linseed oil. The resin can be rosin or ester gum. The thickness of the plastic layer can be varied and is typically 0.02 to 0.06 inches in thickness (Column 6, lines 11-31, 70-75). Typical of other suitable resins are polymethyl methacrylates (Column 5, lines 27-30). Figure 2 is a cross-sectional view of the surface covering and specifically shows that the plastic chips (10) are imbedded in the matrix of fine granules (11) and

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wherein a backing material (20) is also present. Claims 78 and 79 recite that the polymeric material may be selected from the recited Markush groups and Dobry et al. meet the limitation that the polymeric material may be a polymethyl methacrylate. Claims 22-27 and 43-53 are dependent on claims 78 and 79, respectively, and do not positively recite that the polymeric material is a reaction product of a carboxylic acid and an epoxidation product of a carboxylic acid ester and hence claims 22-27 and 43-53 are rejected under Dobry et al. All limitations of claims 19, 20, 22-31, 37, 39, 41, 43- 54, 56-58, 74, 75, 78, and 79 are disclosed in the above-recited reference.

3. Claims 19, 20, 22-31, 37, 39, 41, 43- 54, 56-58, 74, 75, 78, and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris (US 3,325,337).

Harris discloses a resilient linoleum surface covering have inlaid design elements in which particles of accent material are visible interiorly of the design elements (Column 1, lines 10-15). The molded linoleum surface coverings have inlaid, novel design effects which are achieved by using mottle of special composition. The mottle comprises particles of clear or transparent vinyl resin mix which is compatible with linoleum and particles of a linoleum binder (Column 2, lines 5-10). The particles of clear thermoplastic vinyl are particles of hydrolyzed vinyl chloride-vinyl acetate copolymer (Column 2, lines 35-70). The particles of linoleum binder and vinyl resin have an average particle size of less than the thickness of the designs elements (Column 3, lines 4-10). Examples 1 shows that the particle of both the linoleum binder and the vinyl particles may be 0.07 inches. Claims 78 and 79 recite that the polymeric material may

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be selected from the recited Markush groups and Harris meet the limitation that the polymeric material may be a polymethyl methacrylate. Claims 22-27 and 43-53 are dependent on claims 78 and 79, respectively, and do not positively recite that the polymeric material is a reaction product of a carboxylic acid and an epoxidation product of a carboxylic acid ester and hence claims 22-27 and 43-53 are rejected under Dobry et al. All limitations of claims 19, 20, 22-31, 37, 39, 41, 43-54, 56-58, 74, 75, 78, and 79 are disclosed in the above-recited reference.

Response to Arguments

4. Applicant's arguments filed on March 13, 2007 have been fully considered but are not persuasive. Applicants traverse the 35 U.S.C. 102(b) rejection based on Dobry et al. (US 2,962,081) and submit that Dobry et al. fail to teach or suggest a linoleum sheet containing flakes over the entire thickness thereof and that the PTO has mischaracterizes the teachings of Dobry et al. given that Dobry et al. states verbatim, ... depositing uniformly on a backing material a smooth layer of a mixture of fine particles ... then scattering materially larger, irregular, fiat plastic chips on top of the fine particles in such a manner that the chips lie fiat and relatively few of them overlap. (Office Action, Column 1, Lines 61-65). Hence, the Applicants continue to argue this precludes the plastic chips from being distributed throughout the entire thickness or cross section of the sheet, as claimed in Applicants' invention.

As pointed out previously, Dobry et al. disclose plastic composition sheets that are adapted for use as floor coverings and comprise a backing material and a smooth

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layer of a mixture of fine particles and flat plastic chips (Column 1, lines 49-65). The thickness of the plastic layer, which is linoleum, can be varied and is typically 0.02 to 0.06 inches in thickness (Column 6, lines 11-31, 70-75). Furthermore, **Figure 2 is a cross-sectional view of the surface covering and specifically shows that the plastic chips (10) are imbedded in the matrix of fine granules (11) and hence are present over the whole cross section of the plastic composition. In addition, Column 2, lines 47-50 states that "a product having an appearance of a wide range in chip size can be obtained by allowing a few of the chips to overlap at various points"**. Layer 20 is a backing material and does not form part of the sheet comprising the plastic chips and the matrix of fine granules. **In other words, the layer comprising the plastic chips and matrix of fine granules meets the limitations of the claimed planar structure.**

Applicants traverse the rejection of claims 19, 20, 22-31, 37, 39, 41, 43- 54, 56-58, 74, 75, 78, and 79 under 35 U.S.C. 102(b) as being anticipated by Harris (US 3,325,337) and submit Harris does not anticipate the present claims at least because an element as set forth in the present claims, namely the flakes comprising an organic polymeric material, is not found. However, the Examiner maintains that the intermediate product taught by Harris meets the limitations of the claimed invention, i.e., before the mottle becomes the continuous phase. **The mottle comprises particles of clear or transparent vinyl resin mix which is compatible with linoleum and particles of a linoleum binder.** In other words, the mottle of Harris meets the limitations of the flakes of the instant invention.

Hence, the above rejections are maintained.

Allowable Subject Matter

5. Claims 76 and 77 are allowed.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

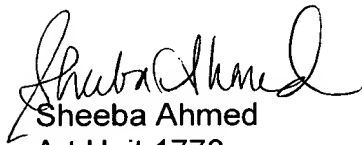
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-

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1504. The examiner can normally be reached on Mondays-Thursdays from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sheeba Ahmed
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May 22, 2007